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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,917	12/22/2000	Antonietta Grasso	D/A0034	3973

7590 02/03/2005

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EXAMINER
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NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/746,917

Applicant(s)

GRASSO ET AL.

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10, 12, 14, 25, 27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 12, 14, 25, 27, 29 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 14, 25, 27 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to communication filed 06/24/04.

#### ***Response to Arguments***

Applicant's arguments have been considered and found persuasive. Hence, the finality of the last office action, mailed 05/10/04, is hereby withdrawn. However, upon reconsideration and a search update, the examiner reaches conclusions discussed below.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25, 27 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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The Claims 25, 27 and 29 as representative are directed to non-statutory subject matter. The claimed steps can be carried out with pencil and paper and are not technologically embodied as a computer process. They represent an abstract idea of recommending a particular item to a user based on item similarities.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 12, 14, 25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko et al. (US 6092049) (Chislenko) in view of Chan et al. (US 6378070) (Chan).

Regarding claim 10, Chislenko discloses: a system for providing item recommendations comprising: a memory (12, fig. 4, Chislenko);

a processor, for storing ratings of items and for generating recommendations for new items based on recommendation criteria (col. 4, lines 44-59, Chislenko);

wherein, responsive to the user request, the processor stores an implicit rating for the requested item in the memory (102, fig. 3), determines whether, based on the implicit rating and the recommendation criteria, to generate an item recommendation, and if the criteria for generating a recommendation is met, generates a recommendation of the new item (110, fig. 3, Chislenko);

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wherein the memory stores user profiles for users of the system (102, fig. 3), wherein each user profile includes a set of user preferences pertaining to items and wherein the processor, responsive to the user request, updates the user's profile with the implicit rating (col. 3, lines 4-67 and col. 7, lines 58-60);

wherein the processor further stores a representation of the recorded item in memory and determines an item similarity for the recorded item (104, fig. 3, Chislenko);

wherein the item similarity comprises an item to item similarity is determined by comparing the stored representation of the recorded item with the stored representations of other recorded items stored in the memory (106, fig. 3, Chislenko);

wherein the processor characterizes content of the recorded item using linguistic tools and wherein the processor determines the item to item similarity between two recorded items by calculating a sum of weights of keywords in common divided by a sum of weights of all keywords associated with the two recorded items (col. 19, lines 55-60, Chislenko).

However, Chislenko didn't disclose: a device, responsive to a user request, for recording an item on a hardcopy medium. On the other hand, Chan discloses: a device, responsive to a user request, for recording an item on a hardcopy medium (col. 2, lines 54-67, Chan). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include a device, responsive to a user request, for recording an item on a hardcopy medium in the system of Chislenko as taught by Chan. The motivation being to enable the system provides and generates a request for a document, transmitting the request to the print server and receiving a document from the print server for printing the document for the user (col. 2, lines 54-67, Chan).

As per claims 12 and 27, all the limitations of these claims have been noted in the rejection of claim 1 above. It is therefore rejected as set forth above.

As per claims 14 and 29, all the limitations of these claims have been noted in the rejection of claim 1 above. It is therefore rejected as set forth above. In addition, Chislenko/Chan discloses: wherein the processor characterizes content of the recorded item using linguistic tools, wherein the processor generates a linguistic user profile for each user comprising a list of terms extracted from user recorded items and frequency of occurrence of such extracted terms and wherein the processor determines an overlap between a user's linguistic profile and a recorded item's linguistic content characterization (col. 13, lines 10-25, Chislenko).

### ***1. Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bobrow et al. (U.S 6562077). Sorting image segments into clusters based on a distance measurement.

Adler et al. (U.S 6651218). Dynamic content database for multiple document genres.

Adler et al. (U.S 6675356). Distributed document-based calendaring system.

Pedersen et al. (U.S 5483650). Method of constant interaction time clustering applied to document browsing.

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## **2. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Cindy Nguyen  
December 8, 2004



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER